

REMARKS

This communication responds to the *Office Action* dated November 4, 2009 and the *Advisory Action* dated February 24, 2010. Claims 1, 12, 13, 18, 19, 20, and 27 are amended, no claims are canceled, and no claims are added. Consequently, claims 1-31, 33, and 34 remain pending in this application. Applicants aver that the amendments are supported by, at least, Applicants' Published Application¹ at [0029], [0026], and FIG. 1.

§ 103 Rejection of the Claims

Claims 1-31, 33, and 34 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Cheok* (U.S. Patent No. 6,934,906) in view of *Shahine* (U.S. Patent No. 7,082,576). Without conceding the propriety of the Examiner's characterization of *Cheok* and *Shahine*, Applicant respectfully submits that these references cannot disclose all the claimed elements, as presently amended.

The recent U.S. Supreme Court decision of *KSR v. Teleflex* provides a tripartite test to evaluate obviousness.

A rationale to support a conclusion that a claim would have been obvious is that ***all the claimed elements were known in the prior art*** and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. (*See KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007)) (Emphasis added).

Cheok and *Shahine* fail to disclose all the claimed elements of independent claims 1, 12, 20, and 27 for at least the following reasons.

I. Receiving Second Video Signal

Claim 1 recites, in part, "receiving a second video signal at said system, the second video signal representing a second video feed different from the first video feed." In the *Office Action*,

¹ U.S. Published Patent Application No. 2004/0098753.

the Examiner cited to operation 403 of FIG. 4, which describes “obtain[ing] second information including a second part of a BIFS scene description stream that contains a reference to an external application,” as disclosing this feature of claim 1. *Office Action* at 4. Further, the Examiner argued that “a first information and a second information are different signals because they contain different information.” *Advisory Action* at paragraph 4. Operation 403 fails to disclose this feature of claim 1 for at least the following reasons.

Operation 403 of *Cheok* merely obtains the “second part of a BIFS scene description stream.” See, *Cheok* at FIG. 4. The first part of the BIFS stream, on the other hand, is obtained at operation 401, which the Examiner relies on to allege “the first video signal” of claim 1. *Office Action* at 3. Even assuming *arguendo* that a BIFS stream is a video feed, the Applicants fail to find any reading within *Cheok* that suggests that the first part of a stream can constitute one video feed while the second part of the stream can constitute a second video feed. In fact, the term “stream,” at most, suggests a single feed. For example, “the bit-stream of the scene description information 225 may be stored … as it is streamed.” *Cheok* at col. 5, lines 43-45. Thus, unlike the first and second video signals of claim 1, *Cheok* does not distinguish the first part of the BIFS stream from the second part of the BIFS stream nor does *Cheok* disclose a first and second video feed whereby the second video feed is different from the first video feed.

Independent claims 12, 20 and 27 recite limitations similar to at least those discussed above with respect to claim 1. In particular, these claims recite “a second video signal.” The Examiner’s assertion that, because the first and second information of *Shahine* contain different information, the first information and the second information are different signals is without basis. As such, and for at least the same reasons described above, *Cheok* fails to disclose these features of independent claims 12, 20 and 27.

With respect to *Shahine*, the addition of *Shahine* does not cure the deficiencies of *Cheok* with respect to claims 1, 12, 20, and 27. In particular, *Shahine* fails to even suggest receiving a first and second video signal, as recited by claims 1, 20, and 27. Therefore, *Shahine* similarly fails to disclose the above features of these claims.

II. Selecting from a plurality of different manners of image combinations based upon user preference information in said system

Claim 1 recites, in part, “the manner in which the images are combined being selected from a plurality of different manners of image combinations based upon user preference information in said system.” In context, claim 1 recites that the manner is defined by a “presentation description comprising a set of instructions that define a manner in which a portion of said first image and a portion of said second image may be combined.”

The Examiner misinterpreted the Applicants’ argument presented in the *Response to Final* dated February 4, 2010. The Examiner stated that “Applicant[s] argue[] that *Cheok* in view of *Shahine* does not meet the limitation requiring that images are displayed in accordance with a presentation description comprising a set of instructions that define a manner for combining the images.” *Advisory Action* at 3, paragraph 3. This interpretation fails to consider the “selected … based upon user preference” feature of claim 1. Therefore, rather than viewing claim 1 so broadly, Applicants wish to direct the Examiner’s attention specifically to the relationship between “user preference” and “manner” as well as the distinction between “instructions” and “manner,” as recited by claim 1.

In the *Office Action*, the Examiner acknowledged that “*Cheok* does not further explicitly teach that the selected manner is chosen based on user preference information in the system.” *Office Action* at 5. However, paraphrasing *Shahine*, the Examiner alleged that “the selected manner” feature is disclosed because:

Shahine teaches a device for composing a displayed scene using a presentation description to arrange data objects (Abstract), wherein the arranged objects include images (col. 13, l. 20-29), in a plurality of manners based on a priority associated with the object (Abstract), wherein the priority is determined based on user preference information stored in the device (col. 8, l. 21-35). *Office Action* at 5.

Applicants point out that *Shahine* actually describes methods and systems “to display a summary of available information based on a *predefined* priority associated with each portion or element of that information.” *Shahine* at Abstract (emphasis added). In relevant part, *Shahine* recites that “a user may view the priority list, and assign desired priorities to each data object, or

change existing priorities, whether predetermined, or previously set by the user.” Col. 8, lines 29-31. “Once priorities have been associated with data objects, … the display manager module 420 then sorts the data objects in order of priority” (col. 9, lines 15-18) and “the display device 430 [is populated] with as many of the data objects as will fit… .” (col. 9, lines 36-38). It follows then that depending on the display area, the priorities associated with the data objects define exactly how the data objects are sorted and, consequently, displayed. In other words, at most, the *user preference of Shahine defines the instructions for displaying the data objects*. In fact, the Examiner shares this same interpretation in the *Advisory Action*. The *Advisory Action* at page 3, paragraph 3 states “*Shahine* may refer to user-specified *instructions* for combining images, or to predetermined *instructions* for combining images.” (emphasis added).

However, claim 1 distinguishes the instructions from the manner, wherein the user preference relates to the manner. Moreover, the user preference of claim 1 is used to select, not define, the manner. Consequently, *Shahine* describes fundamentally different methods and systems.

The Examiner makes additional arguments in the *Advisory Action* that suggests some confusion on the focus of claim 1 that the Applicants wish to clarify. First, the Examiner argues that “*Shahine*’s instructions are not necessarily user-specified.” *Advisory Action* at 3, paragraph 3. Applicants agree. However, the “predetermined instructions” of *Shahine* are irrelevant here because that reference completely fails to suggest that there is any relationship between user preferences and the predetermined instructions, much less that the predetermined instructions are selected based upon user preferences information in the system. Still further, the Examiner stated “nothing in the claims precludes the presentation description from containing user-specified instructions.” *Advisory Action* at 3, paragraph 3. Again, Applicants agree. However, as described above, “user-specified instructions” fail to disclose “the manner …being selected from a plurality of different manners …based upon user preference information in said system,” as recited by claim 1.

For the above reasons, *Shahine* fails to disclose “the manner ...being selected from a plurality of different manners ...based upon user preference information in said system,” as recited by claim 1.

III. Claims 12 and 18

Although the Applicants believe that the original pending claims define over the art of record, the Applicants have amended independent claim 12 to further clarify, in part:

[R]eceiving a plurality of presentation descriptions in said system, the plurality of presentation descriptions each comprising a set of instructions that define a manner in which a portion of said first sequence of images and a portion of said second sequence of images may be combined, and *the plurality of presentation descriptions each including an identifier*; and

selecting one of the plurality of presentation descriptions based upon a selected identifier corresponding to user preference information in the system, the selected presentation description defining the manner in which the sequences of images are combined, and the selected presentation description instructions also defining a sequence of operations performed over time.

Cheok and *Shahine*, singly or in combination, fail to disclose the above features of claim 12. As described above, *Shahine* discloses that a user defines exactly how the data objects are sorted and, consequently, displayed by “configuring” a “priority list.” *Shahine* at Col. 8, lines 27-31. However, a user configuring a priority list in no way discloses this feature of claim 12. Configuring implies editing or modifying an existing item, not “selecting ... based on a selected identifier, the selected identifier being based upon user preference information in said system,” as recited by claim 12. Still further, *Shahine* is completely silent as to “receiving a plurality of presentation descriptions, ... the plurality of presentation descriptions each comprising an identifier.”

Claim 18 depends directly on claim 12. Therefore, dependent claim 18 is allowable for at least the same reasons. Further, claim 18 recites “the selected identifier being based also on demographics of the viewer.” Since neither *Cheok* nor *Shahine* disclose the “selected identifier” nor do they disclose demographics, these references also fail to disclose “the selected identifier also **being based on demographics of the viewer.**”

Since Applicants have shown that not all the claimed elements were known as required by *KSR*, by *Cheok* and *Shahine* singly or in combination, Applicants respectfully request the Examiner to withdraw the rejection under 35 U.S.C. §103 with regard to independent claims 1, 12, 20, and 27. Further, the corresponding dependent claims too are allowable for at least the same reasons. Furthermore, these dependent claims each may contain additional patentable subject matter.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4057 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 5 day of April, 2010.

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